

REMARKS

As an initial matter, the undersigned wishes to thank Examiner Graysay for the courtesy extended in the telephone interview of August 8, 2006. As per the interview and the Interview Summary dated August 14, 2006, Applicants respectfully request reconsideration and withdrawal of the entry of final rejection on the basis that the final rejection was not necessitated by Applicant's amendment of the claims or based upon information submitted by Applicant in an Information Disclosure Statement. See MPEP § 706.07(a).

Claim 1 is amended to correct an informality. At line 2, claim 1 as filed recites a "slab steel plate." Applicants amend claim 1 to recite "slab metal plate" to make claim 1 consistent internally (see line 7 referring to "slab metal plate") and consistent with the dependent claims (e.g., see claims 9 and 10). Entry of these amendments are respectfully requested.

Claims 1-13 stand rejected under 35 USC § 112, first paragraph, for allegedly being based on a disclosure which is not enabling. Applicants respectfully traverse this ground of rejection and request reconsideration and allowance of claims 1-13.

The Examiner misapplies *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976), in arguing that claims to a rectangular concrete tank product that do not include "a slab having a *rectangular* slab plate defining at least *four* sidewalls and at least *four* side panels are not enabled by the disclosure because those elements (a rectangular slab plate with four sidewalls with four side panels) and the associated liquid-tight welds between adjacent elements are critical or essential to practice of the invention, but not included in the claim(s)." *In re Mayhew* involved claims directed to a method and apparatus for producing an alloy coated steel strip. The Court of Customs and Patent Appeals found that the specification *required* a cooling zone at the exit side of the process to be operable. Thus, the holding of *In re Mayhew* is strictly limited to cases where failure to recite a limitation renders a claim itself "wholly inoperative." See *Amgen, Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1338 (Fed. Cir. 2003). Accordingly, where an unclaimed element is not necessary to support an operative invention, rejection for lack of enablement is improper.

Here, claim 1 is directed to a rectangular tank comprising a concrete slab having a slab metal plate anchored thereto, the slab metal plate defining at least one substantially linear concrete sidewall location of a rectangular tank outline and a plurality of preformed concrete side panels each having metal plates attached along a bottom edge and along opposing side edges, the

bottom edge plates being welded in liquid-tight weld to the slab metal plate defining a concrete sidewall location and at least one side metal plate of each side panel being connected to a side metal plate of an adjacent side panel by a connection including at least one liquid-tight weld to define a rectangular tank sidewall. Simply stated, all the remaining sidewalls of the rectangular tank are not required limitations of claim 1 and are not necessary to define an operative rectangular tank. An operative tank can result regardless of the manner of construction of the remaining walls.

The Examiner appears to mistakenly attempt to limit Applicants' claims to a preferred embodiment in the absence of limiting prior art. Features which are merely preferred are not to be considered critical. See MPEP 2164.08(c), citing *In re Goeff*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Applicants further note that the portions of the specification relied upon by the Examiner do not support the necessary requirement that the omitted limitations are required for an operable rectangular tank. Instead, the cited excerpts relate to *preferred embodiments*. For example, the discussion cited at pages 2 and 3 of the specification is expressly directed to a preferred embodiment. See page 2, line 24 ("The rectangular tank *preferably* also includes....") Likewise, the discussion at page 7 is under the heading "DETAILED DESCRIPTION OF THE *PREFERRED EMBODIMENT*." Furthermore, the Examiner cites no authority for the proposition that arguments in an *amendment* can transform an omitted element into something necessary to define an operative invention. Finally, the cited argument is directed to the nature of liquid-tight welds recited in claim 1 and serve merely to distinguish claim 1 from the prior art. Accordingly, reconsideration and withdrawal of this grounds of rejection are respectfully requested.

Claims 1-13 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Again, Applicants respectfully traverse this ground of rejection.

The Examiner appears to be neglecting the express scope of the claims and impermissibly trying to discern an "intended" scope of the claims based upon a recited preferred embodiment and arguments distinguishing the prior art raised in the amendment. However, the claims and specification are clear that in fact the claims are directed to a rectangular tank *comprising* a concrete slab having a slab metal plate anchored thereto defining at least one substantially linear

concrete sidewall location and a plurality of preformed concrete side panels each having metal plates attached along a bottom edge and opposing side edges with the bottom edge plates welded in a liquid-tight weld to the slab metal plate defining a concrete sidewall location and at least one side metal plate of each side panel being connected to a side metal plate of an adjacent side panel by connection including at least one liquid tight weld to define a rectangular tank sidewall. This combination of elements is not taught in the prior art and it is an error for the Examiner to require the Applicants to include limitations of a preferred embodiment not necessary to distinguish over the prior art. See MPEP 2164.08(c), second paragraph. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

For the aforementioned reasons, Applicants respectfully submit claims 1-13 are in condition for allowance and prompt issuance of a Notice of Allowance is respectfully requested. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117 if not otherwise specifically requested. The undersigned hereby authorizes the charge of any required fees not included or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,



Thomas D. Bratschun, #32,966
Swanson & Bratschun, L.L.C.
1745 Shea Center Drive, Suite 330
Highlands Ranch, Colorado 80129
(303) 268-0066